

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow. At the time of the outstanding Office Action, claims 1, 8-12, 19-23, 30-34 and 36-40 were pending. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 1, 8-12, 19-23, 30-34 and 36-40 remain pending in this application.

Prior Art Rejections:

The final Office Action asserts that claims 1, 10-12, 21-23, 32-34 and 37-40 were rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/34189 to Roth et al. (hereinafter “Roth”), and claims 8, 9, 19, 20, 30, 31 and 36 were rejected under 35 U.S.C. §103(a) as being obvious over Roth. The rejections set forth in the outstanding Office Action are respectfully traversed for at least the following reasons.

Independent claims 1, 12 and 23 have been previously amended to include the subject matter of dependent claims 2-5, 13-16 and 24-27 respectively. This includes features including “an **advertisement data registration unit which registers the advertisement data** received by said advertisement data reception unit,” “wherein in a case **where said distribution accepting unit accepts applications for distribution of advertisement data from a plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction.**” (emphasis added) This advertisement data is “**data from a sponsor who wants the advertisement data to be distributed on an advertisement opportunity.**” Independent claims 34 and 38-40 contain analogous features.

Claims 1-5, 10-16, 21-27, 32-34 and 37-40 were rejected under 35 U.S.C. 102(b) as being anticipated by Roth. Roth is directed towards an internet advertising system in which advertises propose bids that “specify a price or amount that the advertiser is willing to pay for the opportunity to display an advertisement (a) to a view who has a particular set of characteristics and (b) on a web site or web page that meets a particular set of criteria.” (page 3, lines 21-24) These proposed bids are in response to view-ops with specific characteristics.

A view-op is described in Roth as the “fact that a viewer has accessed a web page which has an HTML reference to the advertising server.” (page 3, lines 12-17) Roth teaches the following process when a view-op presents itself: the advertising system updates its information about the viewer of the view-op, sends information about the view-op to bidding agents who decide which bids to submit for the view-op, compares bids from the bidding agents, and sends the selected advertisement to the browser to be viewed. (page 8, lines 1-11)

This is in contrast to the invention as claimed, which requires that applications for distribution for an advertisement opportunity are accepted before the advertisement opportunity is put up for auction (“wherein in a case where said distribution accepting unit accepts applications for distribution of advertisement data from a plurality of sponsors for a same advertisement opportunity, said trade process unit puts up the advertisement opportunity for auction,” independent claim 1; independent claims 34 and 38-40 contain an analogous feature.) Rather, as shown above, the view-op is put up for auction before proposed bids are evaluated or submitted. Thus, Roth fails to teach this feature of the invention as claimed.

On page 13 of the Office Action, it asserts that since the above feature is included in a “wherein” clause, it is an optional feature to be given little or no weight, whereby the Office Action refers to M.P.E.P. Section 2111.04. That section of the M.P.E.P. discusses the use of “wherein” clauses, “whereby” clauses, and “adapted to” or “adapted for” clauses, whereby the case law is clear that “whereby”, “adapted to” and “adapted for” clauses are to be given little or no patentable weight; however, “wherein” clauses are not in the same category of these other clauses, whereby they are routinely given patentable weight by the PTO and by the CAFC. Accordingly, the assertions made on page 13 of the Office Action with respect to “wherein” clauses is incorrect.

Further on that page, the Office Action refers to a “Boyd” reference, which does not appear to be of record in this case. It is presumed that this reference should have been made to the Roth reference, and clarification is respectfully requested in this regard.

While page 13 of the Office Action asserts that “the submission of advertisements to the advertising database can occur before an advertisement opportunity presents itself” in the system of Roth, this says nothing about first having “accepted” applications for distribution of

advertisement data before putting up the advertisement opportunity for auction, as explicitly recited in claim 1.

Accordingly, Roth does not teach this explicit feature recited in claim 1.

Roth fails to teach several features of the invention as claimed as well. Specifically, Roth fails to teach the advertisement data registration unit of the invention as claimed. With regards to the advertisement data registration units, the Examiner points to the following two paragraphs of Roth to teach this feature:

“Web page 12 includes an HTML reference to an advertisement stored on advertising web server system 16. Each time client browser 11 displays web page 12, the human viewer 10 will see an advertisement which is provided by advertising web server system 16. Such HTML references are in widespread use and they are implemented using conventional HTML tags. Advertising web server system 16 includes a data base of advertisements 16A, a data base of viewer information 16B, and a bid selection logic 16C. **The bid selection logic 16C receives bids from bidding agents 30A to 30Z which in turn receive information concerning proposed bids from bid input system 18.** For purposes of illustration only three identical bidding agents 30A, 30B and 30Z are specifically shown. The reference number 30 will be used to refer to a typical bidding agent. It should be understood that the system could include any number of bidding agents. For example, a system could include several thousand bidding agents 30. Bid input system 18 provides bidding agents 30 with proposed bids which specify how much should be bid for view-ops with particular characteristics. Each bidding agents 30 evaluates each view-op to determine if the view-op meets the criteria specified in a particular proposed bid and if so how much should be bid.

Each bidding agent 30 evaluates a view-op with respect to one proposed bid to determine if a bid should be submitted. Each proposed

bid includes a list of parameters which specify the particular type of viewer which the advertiser wants to reach. For example, a proposed bid might specify that the advertiser is willing to pay five cents for the opportunity to place an advertisement on a web page which is accessed by a viewer who has accessed three financial web pages and an automotive web page within the last week.” (page 6, line 17 to page 7, line 15, emphasis added)

There is no teaching or suggestion in this passage, or anywhere else in the disclosure of Roth, that advertisement data is registered. Roth teaches that the view-op, which corresponds to an advertisement opportunity, is publicized. However, there is no teaching or suggestion that advertisement data that is to be distributed for an advertisement that is registered.

Page 13 of the Office Action refers to page 8, lines 1-11, and page 19, line 27 to page 20, line 26 of Roth for providing additional support for an advertisement opportunity registration unit, but such portions of Roth do not teach such a feature. Namely, page 8, lines 1-11 of Roth describes that when a view-op opportunity presents itself, an advertising web server system: a) updates information about the viewer; b) sends information about the view-op to bidding agents, c) compares bids from bidding agents to determine which advertisement to display, and d) sends appropriate advertisement data from a database to a browser. None of these features is directly related to the claimed advertisement opportunity registration unit that registers an advertisement opportunity. Also, page 19, line 27 to page 20, line 26 of Roth describes a VOD memory area, which facilitates passing data between objects, and whereby data is placed in the VOD memory area and transmitted to bidding agents. The stored data includes current viewer data, data about advertisers, and site data. This portion of Roth does not disclose, teach or suggest an advertisement opportunity registration unit that registers an advertisement opportunity.

Thus, Roth fails to teach several features of the invention as claimed in independent claim 1.

The other independent claims are patentable for analogous reasons as set forth above with respect to claim 1.

The dependent claims are also patentable for at least the same reasons as the independent claim on which they ultimately depend. In addition, they recite additional patentable features when considered as a whole.

Conclusion:

Since all of the issues raised in the Office Action have been addressed in this Reply, Applicant believes that the present application is now in condition for allowance, and an early indication of allowance is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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